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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,989	07/22/2003	Hideto Yamazaki	501152.20017	8168
7590 Eugene LeDonne, Esq. Reed Smith, LLP 29th Floor 599 Lexington Avenue New York, NY 10022		01/11/2007	EXAMINER FAISON GEE, VERONICA FAYE	
			ART UNIT 1755	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/11/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/624,989

Applicant(s)

YAMAZAKI ET AL.

Examiner

Veronica Faison-Gee

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,10,11,15 is/are rejected.
- 7) ☒ Claim(s) 3,7 and 12-14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Okumura et al (US Patent 5,580,374).

Okumura et al teach an aqueous ink composition comprising 2,5-dimercapto-1,3,4-thiadiazole or its salt in the amount 0.01 to 10 percent by weight, a colorant in the amount of 0.05 to 30 percent by weight, water in the amount of 40 to 90 percent by weight and a water-soluble organic solvent in the amount of 40 percent by weight or less (abstract and col. 1 lines 53-62). The reference further teaches that the colorant may be a pigment (col. 1 lines 63-66 and col. 2 lines 1-7). The water-soluble organic solvent includes polyethylene glycol and diglycerol (col. 2 lines 50+). It is the position of the Examiner that similar compositions with similar amounts would provide clear and convincing evidence that would lead one to conclude that the solid matter can be redissolved in the ink would be the same as claimed by applicant. The composition as taught by Okumura et al appears to anticipate the claimed invention.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1755

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okumura et al (US Patent 5,580,374).

Okumura et al is described above, but fails to specifically exemplify the use of the combination of polyethylene glycol and diglycerol as claimed by applicant. Therefore, it would have been obvious to one of ordinary skill in the art to use the combination of polyethylene glycol and diglycerol as claimed by applicant as Okumura et al also discloses the use of polyethylene glycol and diglycerol but shows no example incorporating them.

It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose... [T]he idea of combining them flows logically from their having been individually taught in the prior art. *In re Kerkhoven*, 626 F. 2d 846, 850, 250 USPQ 1069, 1072 (CCPA 1980). See MPEP 2144.06.

#### ***Allowable Subject Matter***

Claims 3, 7 and 12-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The reference alone or in combination fail to teach the weight ratio of the

Art Unit: 1755

polyethylene glycol and the diglycerol with respect to the pigment is not more than 3, weight ratio of diglycerol with respect to the pigment is not more than 3 and diglycerol is present not less than 50 percent by weight with respect to the total amount of the water-soluble organic solvent.

### ***Response to Arguments***

Applicant's arguments filed 10-20-06 have been fully considered but they are not persuasive.

Applicant argues that Okumura et al never discloses an ink "wherein the ink is solidified into a solid matter when the water contained in the ink is evaporated, and the solid matter is redissolved in the ink which is not solidified".

However, the composition of the reference is identical to the claimed composition and identical composition must have the same properties. See MPEP 2112.01 I. For these reasons, the composition of the reference are presumed to inherently possess the claimed properties.

Applicant argues that Okumura never discloses any example which contains diglycerol and satisfies the above limitation either explicitly or inherently. Applicant also argues that Okumura et al does not disclose the use of polyethylene glycol and diglycerol for the same purpose as disclosed by Applicant.

Okumura discloses various solvents. However, the instant claims would have been obvious because it would have been within the skill of the practicing artisan to select one of the possibilities disclosed by the reference.

### ***Conclusion***

Art Unit: 1755

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Veronica Faison-Gee whose telephone number is 571-272-1366. The examiner can normally be reached on Monday-Thursday and alternate Fridays 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VFG  
1-7-07

  
J.A. LORENGO  
SUPERVISORY PATENT EXAMINER